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REMARKS

Claims 1, 3-5, 7-14, 16-19, and 21-25 are currently pending in the subject application and are presently under consideration. A listing of all pending claims is found at pages 2-5 of this Reply. Claims 1, 13, and 14 have been amended herein in order to clarify the amendments made in the Reply to Office Action dated June 4, 2003. Accordingly, no new search is required by the Examiner, and it is respectfully requested that such amendments be entered in order to advance the subject claims toward allowance.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1, 3-5, 7-12, and 25 Under 35 U.S.C. §112, First Paragraph

Claims 1, 3-5, 7-12, and 25 stand rejected under 35 U.S.C. §112, First Paragraph, because the specification, while being enabling for applying a biasing voltage to the substrate, does not reasonably provide enablement for limitation "a second voltage to the substrate at a location determined by the scanning probe microscope." Independent claims 1 and 14 (from which claims 3-5, 7-12, and 25 respectively depend) have been amended herein to clarify that a first voltage is applied *to the substrate* and a second voltage is applied *to the scribing tip, which is positioned at a location determined by the scanning probe microscope*. Thus, it is the scribing tip that is positioned at a particular location and voltage-biased at that particular location based on information gleaned by the scanning probe microscope regarding defects on the substrate. The amendments to the claims are supported by the specification; for example, "Controller 220...maps substrate 240, or a portion thereof, into a grid wherein each portion of the grid corresponds to an XY position." (Page 7, lines 16-19.) Furthermore, "[w]hen defects are located, system 300 uses the defect map and data from the microscope measuring tip 316 to position the scribing tip 318 over the defect." (Page 9, lines 26-27.) "The electric field is applied by *biasing substrate 240 to a first voltage and tip 216 to a second voltage*." (Page 8, lines 20-21.)

In view of the above, it is respectfully requested that this rejection be withdrawn.

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II. Rejection of Claims 13, 14, 16, 18, 21, 23, and 24 Under 35 U.S.C. § 103(a)

Claims 13, 14, 16, 18, 21, 23, and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yedur *et al.* (U.S. 6,197,455) in view of Li *et al.* (U.S. 6,181,097). This rejection should be withdrawn for at least the following reasons. Yedur *et al.* does not qualify as a citable reference against the subject application in view of 35 U.S.C. § 103(c), reproduced below:

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (e), (f), and or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The subject application and Yedur *et al.* (U.S. Patent 6,197,455) were, at the time the invention of the subject application was made, owned and/or subject to an obligation of assignment to the same entity (Advanced Micro Devices, Inc.). See Reel 011322, Frame 0701. Therefore, Yedur *et al.* is not a citable reference against the present application in an obviousness rejection. Li *et al.* fails to teach or suggest every aspect of the present invention as set forth in the subject claims. Accordingly, withdrawal of this rejection and allowance of the subject claims is respectfully requested.

III. Rejection of Claims 17 and 19 Under 35 U.S.C. § 103(a)

Claims 17 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Yedur *et al.* (U.S. 6,197,455) in view of Li *et al.* (U.S. 6,181,097), and further in view of Ellings *et al.* (U.S. 5,866,807). This rejection should be withdrawn for at least the following reasons. Yedur *et al.* is not a proper reference under 35 U.S.C. § 103(a).

As stated above with regard to Section II, Yedur *et al.* was subject to an obligation of assignment to a common assignee at the time the present invention was made. Because Yedur *et al.* qualifies as a reference only under 35 U.S.C. 102(e), and due

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to the obligation of assignment to a common assignee, Yedur *et al.* is not a citable reference against the subject claims. Furthermore, neither Li *et al.* nor Ellings *et al.*, alone or in combination, teach or suggest every aspect of the present invention as set forth in the subject claims. In view of such, it is respectfully submitted that this rejection should be withdrawn.

IV. Rejection of Claims 22 Under 35 U.S.C. § 103(a)

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Yedur *et al.* (U.S. 6,197,455) in view of Li *et al.* (U.S. 6,181,097), and further in view of Koyanagi *et al.* (U.S. 5,627,815). This rejection should be withdrawn for at least the following reasons. Yedur *et al.* is not a proper reference under 35 U.S.C. § 103(a).

As stated above with regard to Sections II and III, Yedur *et al.* was subject to an obligation of assignment to a common assignee at the time the present invention was made. Because Yedur *et al.* qualifies as a reference only under 35 U.S.C. 102(e), and due to the obligation of assignment to a common assignee, Yedur *et al.* is not a citable reference against the subject claims. Furthermore, neither Li *et al.* nor Koyanagi *et al.*, alone or in combination, teach or suggest every aspect of the present invention as set forth in the subject claims. In view of such, it is respectfully submitted that this rejection should be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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